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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,560	01/17/2001	Robert Wayne Glenn JR.	8392	6902

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EXAMINER

CHANNAVAJALA, LAKSHMI SARADA

ART UNIT PAPER NUMBER

1615

DATE MAILED: 08/10/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,560

Applicant(s)

GLENN ET AL.

Examiner

Lakshmi S Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 11-16, 18-26, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 11-16, 18-26, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Receipt of supplemental amendment dated 3-24-04 is acknowledged.

Claims 4, 5, 7-10, 17, 27, 28, 31 and 32 are canceled. Claims 1-3, 6, 11-16, 18-26 and 29-30 are pending.

Response to Arguments

In response to the amendments dated 11-10-03 and 3-24-04; and a terminal disclaimer dated 1-20-04, the previous outstanding rejections have been withdrawn. Accordingly, the arguments presented by applicants are moot. The following new rejection is applied to the pending claims:

Double Patenting

Claims 1-3, 6, 11-16, 18-26 and 29-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,544,499 in view of Zysman et al (US 5,362,494) and claims 1-19 of U.S. Patent No. 6,703,007 in view of Zysman et al (US 5,362,494). Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claims as well the claims of the above patents are directed to compositions comprising a reactive compound having a protected thiol group, and a mono or multifunctional cosmetically active functional group. Instant dependent claims recite the same use of the composition i.e., treating amino acid based substrates, in particular hair, which reads on the claimed hair treatment compositions of the above patents. Instant claims recite an aqueous continuous phase comprising the reactive compound and a bilayer emulsion formed by a combination of a quaternary ammonium halide and cholesterol in

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the ratio of 0.5:1.0 to 1.5:1.0. The above-patented claims fail to recite the bilayer emulsion of the instant claims.

Zysman teaches oil-in-water and water-in-oil cosmetic, dermo-pharmaceutical compositions containing non-ionic and ionic amphiphilic surfactants, which form vesicles i.e., a bi-layer emulsion. With respect to instant combination of cholesterol and quaternary ammonium surfactants, Zysman teaches addition of one more charged lipid to the amphiphilic lipids such as sterols (e.g., cholesterol), quaternary ammonium derivatives etc (col. 7, lines 5-27), so as to impart stability to the vesicles by preventing their flocculation and fusion, as well as increase their encapsulation. Zysman teaches various cosmetic compositions including hair care and hair treatment compositions (col. 11). Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to include the vesicles and surfactants such as cholesterol or quaternary ammonium compounds of Zysman in the hair care compositions mentioned above (of above patented claims) as emulsifying agents and agents to deliver active materials because Zysman teaches the vesicles for dispersing and delivering active agents and suggests that the lipids decrease vesicle permeability, increase their stability, prevent flocculation of the vesicles and finally enhance the encapsulation. With respect to the percentages and ratios of surfactants, Zysman teaches 0.5 to 50% vesicle forming lipids. Further, optimizing the amounts of solvents, active substances and additional lipids such as cholesterol with an expectation to deliver the active substances to the intended site would have been obvious for one of an ordinary skill in the art.

Claims 1-3, 6, 11-16, 18-26 and 29-30 are directed to an invention not patentably distinct from claims 1-18 of commonly assigned U.S. 6,544,499 or claims 1-19 of commonly assigned

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U.S. 6,703,007. As explained above, both the patents cited, disclose the instant reactive components for treating hair compositions.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned 6,544,499 and 6,703,007, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Claims 1-3, 6, 11-16, 18-26 and 29-30 are rejected under 35 U.S.C. 103(a) as being obvious over US 6,544,499 or US 6,703,007.

The applied references have a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of

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invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2). Both the references cited above teach hair care or hair treatment compositions comprising reactive compounds comprising a protected thiol group and a cosmetically active functional group. The above patents suggest that protected thiol group containing molecules as "hooks" for delivering the hair care actives to keratin fibers and retaining them for a long time. While the above patents fail to specifically suggest the claimed cholesterol and quaternary ammonium halide bilayer emulsions, both references suggest employing surfactants and other hair care additives so as to prepare the hair care compositions as gels, sprays, emulsions, lotions etc. accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to prepare the hair care compositions (of above disclosures) containing thiol protected reactive compounds hooked to hair care actives in the form of a emulsions employing suitable surfactants with an expectation to successfully deliver the hair care agents and retain them on the hair fibers for the desired amount of time.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.30 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lakshmi S Channavajjala
Examiner
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August 5, 2004